



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

CR

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,463	11/14/2001	James H. Ailey	10368/25901	7559

26116 7590 04/10/2003

SIDLEY AUSTIN BROWN & WOOD LLP  
717 NORTH HARWOOD  
SUITE 3400  
DALLAS, TX 75201

EXAMINER

STASHICK, ANTHONY D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 04/10/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/992,463	AILEY ET AL.	
	Examiner	Art Unit	
	Anthony D Stashick	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 5-26 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 14 November 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> .	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4, drawn to different portions of an insole made of material of different flexibility that controls the flexibility of the insole, classified in class 36, subclass 43.
  - II. Claims 5-26, drawn to a base strip located under an insole, the base strip controlling the flexibility of the insole, classified in class 36, subclass 44.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as a strip used underneath or on top of a sole or midsole to control flexibility of a shoe. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Charles Catropia on March 31, 2003 a provisional election was made without traverse to prosecute invention II, claims 5-26. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-4 are hereby withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 5, 8-9, 14-15, 18 and 20-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Sewall 2,252,417. Sewall '417 discloses all the limitations of the claims including the following: an insole with a periphery having medial, lateral, forward and rearward edges (see especially, Figures 18 and 19); a base strip 55, 53, 71 with a first portion 55 positioned at the rear foot region of the insole; a second portion 53 of the base strip positioned at the forefoot region of the insole; a toe piece 71 positioned at the toe region of the insole; the second portion 53 of the base strip more flexible than the first portion 55 of the base strip (see page 4, left col. lines 6-25); footwear upper attached to sole to form receiving area (typical for a "shoe"); foot bed positioned above strip portions (see Figures 18 and 19); insole positioned on the inside surface of the outsole (typical positioning of an insole and the invention in Sewall '417 is an insole); holding members affix insole to sole at shank portion (adhesive).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a

Art Unit: 3728

person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sewall 2,252,417.

Sewall '417 discloses all the limitations of the claims as noted above. Sewall also discloses, in another embodiments, the desire to skive the ends of portions of the insole that at fasten in line, to prevent the feel of the transition from one portion to the other. Therefore, it would have been obvious to skive all portion of the base strip and insole where the portions come together to prevent the feel of the transition from one portion to the other and to prevent excessive build-up of the insole in the area where the portions come together.

10. Claims 7, 10-13, 16, 17, 18 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sewall 2,252,417 as applied to claims 5, 8, 14 and 25 above in view of Moronaga et al.

4,633,598. Sewall '417 as applied to claims 5, 14 and 25 above disclose all the limitations substantially as claimed except for the third portion positioned in contact with the first portion and shaped with the first portion, a tuck portion underlying the first portion, the foot bed having an intermediate portion and a surface portion with the surface portion being made of textile and the intermediate portion being made of foam material. Moronaga et al. '598 teaches that a tuck portion 4 can be placed underneath the heel or rear portion of an insole and shaped as the rear portion of the insole to aid in the absorbing of shock from impact of the user's foot with the ground. Therefore, it would have been obvious to place a third portion, such as the tuck shown in Moronaga et al. '598, under the first portion in the rear foot area of Sewall '417, to aid in absorbing the shock of the user's initial contact with the ground. Furthermore, Moronaga et al. '598 teaches that an insole with a lower layer can have a foot bed including an intermediate portion formed of foamed material (see col. 2, lines 3-9) and a top surface made of soft material such as fabric (textile) to aid in making the insole feel more comfortable to the user. Therefore, it would have been obvious to make the upper layer of the insole of Sewall '417 out of

Art Unit: 3728

layers of foam and fabric, as taught by Moronaga et al. '598, to aid in giving more comfort and cushioning to the user's foot during use.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Tuesday through Friday from 8:30 am until 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Art Unit: 3728

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line                    1-800-786-9199  
Internet PTO-Home Page                <http://www.uspto.gov/>



Anthony D Stashick  
Primary Examiner  
Art Unit 3728

ADS  
April 6, 2003